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Wayne Odom

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ROBERT RYAN MORISHITA  
MORISHITA LAW FIRM, LLC  
3800 HOWARD HUGHES PKWY,  
SUITE 850  
LAS VEGAS, NV 89169

EXAMINER

HOEL, MATTHEW D

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/942,520

Applicant(s)

ODOM, WAYNE

Examiner

Matthew D. Hoel

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7, 8, 12 and 14-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 8, 12 and 14-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 7, 8, 12, and 14 to 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita, et al. (U.S. patent 5,967,894 A) in view of Richardson (U.S. patent 5,042,809 A).

4. As to Claim 15: '894 teaches a method of conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of indicia arranged in sets of at least two indicia each (Abst.; hand comprising five indicia, Fig. 6). The player in '894 makes a wager to play each of a series of hands (sequence played for each hand, Fig. 7; indications showing remaining possible hands, Figs. 8a-c). For each hand of play, '894 randomly selects and displays a plurality of individual indicia

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from the inventory, the combination of indicia selected and displayed defining at least one hand outcome (hands determined and displayed, Fig. 7; hands dealt, Col. 3, Line 58 to Col. 4, Line 3). The dealt indicia are depleted from play in subsequent hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. '894 compares the hand outcome to a predetermined schedule of winning outcomes and if the hand matches one of the schedule of winning outcomes, issues an award to the player (Figs. 8a-c; Col. 8, Lines 31 to 42).

5. Regarding the hand-to-hand play of '894, the examiner respectfully disagrees with the applicants on this regard. The player of '894 is able to insert plural medals (Col. 4, Line 66 to Col. 5, Line 14). The player is able to bet one medal on a particular hand (5:50-65 "an inserted medal," also "1 BET" button 33, Fig. 4; the player is able to bet one or plural medals on a given hand, "1 BET" 33 or "MAX BET" 32, Fig. 4, Col. 6, Lines 43 to 59; Col. 8, Lines 42 to 53, play continues until the player runs out of medals or player presses "COLLECT/PAYOUT", in the event the player inserts plural medals and the player only bets one medal per hand by pressing "1 BET" each time, the game will necessarily involve hand-to-hand play of several subsequent hands for at least as long as the player has medals, for example if the player inserts five medals the player

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will have at least five hands to play in the game, and each time the indicia left in the deck of virtual cards will be more depleted as more cards are dealt from the deck on each successive hands). The cards in '894 are randomly generated and are not in any particular order (Col. 3, Lines 58 to 62. It is widely known in the art that a standard poker deck used in most poker games is a 52-card deck with 4 suits of 13 cards each, and the possible combinations of '894 are eliminated as indicia are drawn, so a pool of finite indicia is depleted, though it is not generated or constituted in a predetermined serial order which is not required by the claim language.

6. Prior to play, '894 displays the possible winning hands remaining in the indicia set in the inventory as depleted and displays any scheduled winning outcomes eliminated as a result of depletion of the inventory (Figs. 8a-c). '809, however, teaches displaying the number of indicia remaining in the indicia set in the inventory as depleted and displays and scheduled winning outcomes eliminated as a result of depletion of the indicia inventory (Fig. 3: 10 of 12 majors left, 12 of 12 majors left, 16 of 16 majors left, 8 of 8 majors left, and 8 of 8 majors left; also indicators 36 of Fig. 3 showing number of chances remaining). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the more explicit indication of remaining indicia of '809 to the game of '894. Both games are games in which indicia are depleted and numbers of remaining winning outcomes are displayed to players (Figs. 8a-c, '894; Fig. 3, '809). The only major difference between '809 and '894 is that '809's winning combinations comprise of a single indicium and the winning combinations of '894 comprise are a combination of indicia. Claim 19 of '809 specifies sets of three symbols,

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which are analogous to the five-symbol combinations of '894. Some suggestion for this modification can also be found in Morris, et al. (U.S. patent 5,324,035 A). '035 is an indicia-depletion game very similar to '809 (Abst.); '035 displays the number of tickets left (168, Fig. 14) and the total number of winning tickets at each level (Fig. 15), also indicating when a player wins (Fig. 17); one of '035's embodiments is a poker game (Col. 5, Line 39). The advantage of this combination would be to more precisely indicate which indicia remain in the pool of indicia rather than simply indicating which kinds of winning combinations remain as is done in '894 Figs. 8a-c. It would be particularly advantageous to indicate specific remaining indicia in '894, because the player is able to indicate which cards to hold or discard (Fig. 8c), so knowing the actual indicia would allow the player to make his or her choices as to which indicia to hold or discard much more precise.

7. As to Claim 19: '894 teaches an electronic device for conducting a game for a player, the game utilizing an inventory of X number of game indicia arranged in sets of at least two indicia each when the inventory is fully constituted (Abst.; hand comprising five indicia, Figs. 1, 6). '894 teaches a computer processor storing data corresponding to the inventory (Fig. 5), a video display (Fig. 1), and means for a player to make a wager and prompt play of a game (medal selector 41, switches 53, and medal hopper 42, Fig. 5). The processor of '89, in response to the prompt, is configured to randomly select and display at the display a combination of individual indicia selected from the inventory of indicia (Fig. 6), the selected and displayed indicia combination defining at least one outcome (Figs. 8a-c), and the processor is configured to remove the selected

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indicia from selection for future hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. The processor is configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure (Figs. 8a-c), to issue an award for each selected and displayed winning outcome (Col. 8, Lines 31 to 42), to control the display prior to play of the next hand data corresponding to the remaining inventory of indicia sets depleted of the displayed game indicia including the display of indicia from the inventory such that one or more scheduled winning outcomes are unavailable due to depletion (Figs. 8a-c, the examiner notes that this claim language only requires the display of winning outcomes no longer available and not the display of remaining individual indicia). The processor of '894 is configured to, for the next hand of play, select indicia from the depleted inventory (Fig. 6; Col. 3, Line 58 to Col. 4, Line 3).

8. As to Claim 23: '894 teaches a method for conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of individual indicia (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). The player of '894

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makes a wager to play each of a series of hands (Fig. 7). For each hand of play, '894 randomly selects and displays a plurality of individual indicia from the inventory, the combination of individual indicia selected and displayed defining a winning or losing outcome for the hand (Figs. 8a-c), and depleting said individual indicia from the inventory available for play of the next hand (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. '894 issues an award to the player for a winning outcome (Figs. 8a-c; Col. 8, Lines 31 to 42). Prior to the commencement of the next hand of play, '894 displays to the player information regarding winning outcomes eliminated by the depletion of indicia (Figs. 8a-c). '894 allows the player to make another wager to play a hand using the depleted inventory (Fig. 7; game continues, Col. 8, Lines 42 to 53).

9. As to Claim 24: '894 teaches a method for conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of indicia arranged in indicia sets of at least two indicia sets each (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). The player of '894 makes a wager to play each of a series of hands (Fig. 7). '809 teaches arranging the inventory into a random serial order 1



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through X (chance symbols randomly generated and shuffled into array, Fig. 5A). '894 serially selects and displays a plurality of individual indicia from the inventory (Fig. 7), the combination of selected and displayed individual indicia defining a winning or losing outcome (Figs. 8a-c), and depleting the displayed indicia from the inventory available for play of subsequent hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. For a winning outcome, '894 issues an award to the player (Figs. 8a-c; Col. 8, Lines 31 to 42). Prior to the play of the next hand, '894 displays to the player any winning outcomes eliminated by depletion of the indicia (Figs. 8a-c). '809 displays the number of each indicia remaining in each indicia set in the inventory as depleted of the prior selected and displayed inventory (Fig. 3). The player of '809 can make another wager to play the game using the depleted inventory or can command reconstitution of the inventory to X number of indicia prior to the play of the next game.

10. As to Claim 25: '894 teaches a method of conducting a wagering game using an inventory of indicia sets, the inventory when fully constituted having X number of indicia (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). '894 allows a player to make a

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wager to play a game (Fig. 7). For each hand of play, '894 randomly selects and displays a plurality of indicia from the inventory into the coordinates of a game matrix (Fig. 7), the combinations of indicia in the game matrix defining a plurality of winning or losing outcomes (Figs. 8a-c), and depleting the displayed indicia from the inventory available for play of subsequent hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. Prior to play of a subsequent hand, '809 displays the number of indicia remaining in the sets in the inventory as depleted of the prior selected and displayed inventory and any winning outcomes eliminated as a result of depletion (Fig. 3). '809 gives the player the option to make another wager to play a next game (Col. 11, Lines 37 to 45) using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the play of the next game (Abst.; new deal, Fig. 2; new screen 42 of Fig. 4; Col. 3, Line 67 to Col. 4, Line 3).

11. As to Claim 26: '894 teaches an electronic device for conducting a game for a player (Abst., Fig. 1). The game utilizes an inventory of X number of game indicia when the inventory is fully constituted (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c).

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'894 teaches a computer processor storing data corresponding to the inventory (Fig. 5), a video display (Fig. 1), and means for a player to make a wager and prompt play of a game (medal selector 41, switches 53, and medal hopper 42, Fig. 5). The processor of '89, in response to the prompt, is configured to randomly select and display at the display a combination of individual indicia selected from the inventory of indicia (Fig. 6), the selected and displayed indicia combination defining at least one outcome (Figs. 8a-c), and the processor is configured to remove the selected indicia from selection for future hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. The processor is configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure (Figs. 8a-c), to issue an award for each selected and displayed winning outcome (Col. 8, Lines 31 to 42), to control the display prior to play of the next hand data corresponding to the remaining inventory of indicia sets depleted of the displayed game indicia including the display of indicia from the inventory such that one or more scheduled winning outcomes are unavailable due to depletion (Figs. 8a-c, the examiner notes that this claim language only requires the display of winning outcomes no longer available and not the display of remaining individual indicia). '809 gives the player the option to make another wager to play a next game

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(Col. 11, Lines 37 to 45) using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the play of the next game (Abst.; new deal, Fig. 2; new screen 42 of Fig. 4; Col. 3, Line 67 to Col. 4, Line 3).

12. As to Claims 7, 17, and 27: '809 discloses reconstituting the inventory to X number of indicia when all of the major prizes have been awarded (Abst.). '809 does not disclose reconstituting to X indicia when a predetermined number of indicia remain in inventory. The applicants have not stated how this limitation solves any stated problem or is for any particular purpose. '809 does disclose reconstituting the pool of indicia at any time an indication is received by a player after at least one chance has been played (Abst.). 7In any event, this limitation is widely known in the art. Scarne in his chapter on Blackjack discloses a cut card 40 cards above the bottom of the stack of cards when cards are dealt from a stack comprising four decks of cards (Pages 282 to 284). The stack is automatically reshuffled when the cut card is revealed. This, along with the use of four decks instead of one, makes card counting extremely difficult and is a deterrent to cheating. Scarne also teaches the dealer reconstituting the deck at any time upon noticing player actions (Page 287), again, to prevent cheating. The examiner believes that this is sufficient motivation to make this modification to the game of the combination of '894 and '809. Moreover, the 103 combination of '894 and '809, or the applicants' own invention, would perform equally well modified to incorporate this limitation. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified '809 or '894 such that the deck is reconstituted when a predetermined number of indicia remain in the inventory,

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because such a modification would have been an obvious design choice which fails to patentably distinguish above these references.

13. As to Claims 8, 14, 18, and 22: '809 randomly selects and displays indicia by arranging the indicia into a random, serial order 1 through X and selects and displays the indicia in order from the arranged inventory (Fig. 5A).

14. As to Claims 12 and 21: '894 allows the player to bet on a single payline (single hand of cards, Fig. 6). '894 does not address the limitation of multiple paylines. '809 does suggest this as it allows players to play multiple parallel games at the same time (Fig. 3). The 103 combination of '894 and '809 would thus have multiple paylines. The applicant has not stated that multiple paylines solves any stated problem or is for any particular purpose; it appears to be merely another embodiment. Moreover, it appears that '894, or the applicants' invention would perform equally well modified to incorporate multiple paylines. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified '894 to incorporate multiple paylines, because such a modification would have been considered a mere design choice which fails to patentably distinguish above '894.

15. As to Claims 16, 20, and 28: '809 gives the player the option to make another wager to play a next game (Col. 11, Lines 37 to 45) using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the play of the next game (Abst.; new deal, Fig. 2; new screen 42 of Fig. 4; Col. 3, Line 67 to Col. 4, Line 3).

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16. Alternatively, Claims 7, 8, 12, and 14 to 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita, et al. (U.S. patent 5,967,894 A) in view of Richardson (U.S. patent 5,042,809 A) and further in view of Fuchs (U.S. patent 5,630,753 A).

17. As to Claim 15: '894 teaches a method of conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of indicia arranged in sets of at least two indicia each (Abst.; hand comprising five indicia, Fig. 6). The player in '894 makes a wager to play each of a series of hands (sequence played for each hand, Fig. 7; indications showing remaining possible hands, Figs. 8a-c). For each hand of play, '894 randomly selects and displays a plurality of individual indicia from the inventory, the combination of indicia selected and displayed defining at least one hand outcome (hands determined and displayed, Fig. 7; hands dealt, Col. 3, Line 58 to Col. 4, Line 3). The dealt indicia are depleted from play in subsequent hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. '894 compares the hand outcome to a predetermined schedule of winning outcomes and if the hand matches one of the schedule of winning outcomes, issues an award to the player (Figs. 8a-c; Col. 8, Lines 31 to 42).

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18. Prior to play, '894 displays the possible winning hands remaining in the indicia set in the inventory as depleted and displays any scheduled winning outcomes eliminated as a result of depletion of the inventory (Figs. 8a-c). '809, however, teaches displaying the number of indicia remaining in the indicia set in the inventory as depleted and displays and scheduled winning outcomes eliminated as a result of depletion of the indicia inventory (Fig. 3: 10 of 12 majors left, 12 of 12 majors left, 16 of 16 majors left, 8 of 8 majors left, and 8 of 8 majors left; also indicators 36 of Fig. 3 showing number of chances remaining). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the more explicit indication of remaining indicia of '809 to the game of '894. Both games are games in which indicia are depleted and numbers of remaining winning outcomes are displayed to players (Figs. 8a-c, '894; Fig. 3, '809). The only major difference between '809 and '894 is that '809's winning combinations comprise of a single indicium and the winning combinations of '894 comprise are a combination of indicia. Claim 19 of '809 specifies sets of three symbols, which are analogous to the five-symbol combinations of '894. Some suggestion for this modification can also be found in Morris, et al. (U.S. patent 5,324,035 A). '035 is an indicia-depletion game very similar to '809 (Abst.); '035 displays the number of tickets left (168, Fig. 14) and the total number of winning tickets at each level (Fig. 15), also indicating when a player wins (Fig. 17); one of '035's embodiments is a poker game (Col. 5, Line 39). The advantage of this combination would be to more precisely indicate which indicia remain in the pool of indicia rather than simply indicating which kinds of winning combinations remain as is done in '894 Figs. 8a-c. It would be

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particularly advantageous to indicate specific remaining indicia in '894, because the player is able to indicate which cards to hold or discard (Fig. 8c), so knowing the actual indicia would allow the player to make his or her choices as to which indicia to hold or discard much more precise.

19. Fuchs, however, teaches hand-to-hand display of remaining game indicia in a video poker game (Figs. 1 to 3; indications of possible winning ways in a poker game, 6:6-36; more general teaching, Fig. 5, 9:52-67). The Board noted in the related 09/977,138 case: "We acknowledge that the sections of Fuchs the examiner relies upon appear to disclose depletion of the group of symbols (cards in a deck) over several games. However, in our review of Fuchs we find that Fuchs' uses the term game to mean an additional play of cards, i.e. Fuchs uses the term game to both describe the inter hand deal of cards and the intra hand deal of cards. See for example Fuchs states, in column 6, lines 20-25: 'In the present case, since it is a type of poker game that is being played, the computer unit 5 has suggested that two game symbols 3', namely the two aces, should be stored and at the same time it displays the possible ways of winning the next game by obtaining five, four or three aces and the possible ways of winning are assigned various values in the display fields .... ' Thus, we find it clear that Fuchs is using the term game to include the deal of cards within a hand of poker. Further, we find no examples in Fuchs that discuss the deck of cards is not being reconstituted and randomized between segments of play where wagers are distributed (i.e. hands of poker). Rather, we find that Fuchs is ambiguous as to whether the deck of cards is reconstituted and randomized, or is allowed to be depleted, between hands." It



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would have been obvious to one of ordinary skill in the art to apply the hand-to-hand indication of possible winning hands of Fuchs to the game of Kinoshita '894. Depleting a set of indicia, or deck of cards, from hand to hand would create a much more realistic game. The examiner notes the following from Scarne ("Scarne's Encyclopedia of Card Games," by John Scarne, 1973, HarperCollins, New York, Poker chapters): On Page 14 indicating the basic draw poker rules, if there are not enough cards in the deck to complete the current deal, the discards can be shuffled and dealt. Also it is recommended that two decks be used so that a player can call for a change of decks after the present deal is done. Moody in U.S. patent 5,823,873 A discusses a poker game in which multiple hands are dealt from a set of indicia comprising six 52-card decks dealt from a shoe (12:44-60). It is thus well known in the art to deal multiple hands from a single deck of cards or a pile of cards comprising more than one deck in a poker game. Applying this to the display of remaining possible hands of '894 would have the effect and advantage of making the poker game of '894 much more realistic and instructive since the remaining hands over the course of the game will be displayed instead of just the possible hands remaining on a single hand of play based on the cards drawn on that particular hand.

20. As to Claim 19: '894 teaches an electronic device for conducting a game for a player, the game utilizing an inventory of X number of game indicia arranged in sets of at least two indicia each when the inventory is fully constituted (Abst.; hand comprising five indicia, Figs. 1, 6). '894 teaches a computer processor storing data corresponding to the inventory (Fig. 5), a video display (Fig. 1), and means for a player to make a

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wager and prompt play of a game (medal selector 41, switches 53, and medal hopper 42, Fig. 5). The processor of '894, in response to the prompt, is configured to randomly select and display at the display a combination of individual indicia selected from the inventory of indicia (Fig. 6), the selected and displayed indicia combination defining at least one outcome (Figs. 8a-c), and the processor is configured to remove the selected indicia from selection for future hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. The processor is configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure (Figs. 8a-c), to issue an award for each selected and displayed winning outcome (Col. 8, Lines 31 to 42), to control the display prior to play of the next hand data corresponding to the remaining inventory of indicia sets depleted of the displayed game indicia including the display of indicia from the inventory such that one or more scheduled winning outcomes are unavailable due to depletion (Figs. 8a-c, the examiner notes that this claim language only requires the display of winning outcomes no longer available and not the display of remaining individual indicia). The processor of '894 is configured to, for the next hand of play, select indicia from the depleted inventory (Fig. 6; Col. 3, Line 58 to

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Col. 4, Line 3). The displaying of remaining possible winning hand from one hand of play to another are obvious for the reasons outlined regarding Claim 15.

21. As to Claim 23: '894 teaches a method for conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of individual indicia (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). The player of '894 makes a wager to play each of a series of hands (Fig. 7). For each hand of play, '894 randomly selects and displays a plurality of individual indicia from the inventory, the combination of individual indicia selected and displayed defining a winning or losing outcome for the hand (Figs. 8a-c), and depleting said individual indicia from the inventory available for play of the next hand (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. '894 issues an award to the player for a winning outcome (Figs. 8a-c; Col. 8, Lines 31 to 42). Prior to the commencement of the next hand of play, '894 displays to the player information regarding winning outcomes eliminated by the depletion of indicia (Figs. 8a-c). '894 allows the player to make another wager to play a hand using the depleted inventory (Fig. 7; game continues, Col. 8, Lines 42 to 53). The

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displaying of remaining possible winning hand from one hand of play to another are obvious for the reasons outlined regarding Claim 15.

22. As to Claim 24: '894 teaches a method for conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of indicia arranged in indicia sets of at least two indicia sets each (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). The player of '894 makes a wager to play each of a series of hands (Fig. 7). '809 teaches arranging the inventory into a random serial order 1 through X (chance symbols randomly generated and shuffled into array, Fig. 5A). '894 serially selects and displays a plurality of individual indicia from the inventory (Fig. 7), the combination of selected and displayed individual indicia defining a winning or losing outcome (Figs. 8a-c), and depleting the displayed indicia from the inventory available for play of subsequent hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. For a winning outcome, '894 issues an award to the player (Figs. 8a-c; Col. 8, Lines 31 to 42). Prior to the play of the next hand, '894 displays to the player any winning outcomes eliminated by depletion of the indicia (Figs. 8a-c). '809 displays the number of each

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indicia remaining in each indicia set in the inventory as depleted of the prior selected and displayed inventory (Fig. 3). The player of '809 can make another wager to play the game using the depleted inventory or can command reconstitution of the inventory to X number of indicia prior to the play of the next game. The displaying of remaining possible winning hand from one hand of play to another are obvious for the reasons outlined regarding Claim 15.

23. As to Claim 25: '894 teaches a method of conducting a wagering game using an inventory of indicia sets, the inventory when fully constituted having X number of indicia (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). '894 allows a player to make a wager to play a game (Fig. 7). For each hand of play, '894 randomly selects and displays a plurality of indicia from the inventory into the coordinates of a game matrix (Fig. 7), the combinations of indicia in the game matrix defining a plurality of winning or losing outcomes (Figs. 8a-c), and depleting the displayed indicia from the inventory available for play of subsequent hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. Prior to play of a subsequent hand, '809 displays the number of indicia

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remaining in the sets in the inventory as depleted of the prior selected and displayed inventory and any winning outcomes eliminated as a result of depletion (Fig. 3). '809 gives the player the option to make another wager to play a next game (Col. 11, Lines 37 to 45) using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the play of the next game (Abst.; new deal, Fig. 2; new screen 42 of Fig. 4; Col. 3, Line 67 to Col. 4, Line 3). The displaying of remaining possible winning hand from one hand of play to another are obvious for the reasons outlined regarding Claim 15.

24. As to Claim 26: '894 teaches an electronic device for conducting a game for a player (Abst., Fig. 1). The game utilizes an inventory of X number of game indicia when the inventory is fully constituted (Abst.; while '894 does not explicitly disclosed a fixed number of indicia, it is inherent that the number is fixed since winning combinations become unavailable as indicia are dealt one by one from the pool of indicia, Figs. 8a-c). '894 teaches a computer processor storing data corresponding to the inventory (Fig. 5), a video display (Fig. 1), and means for a player to make a wager and prompt play of a game (medal selector 41, switches 53, and medal hopper 42, Fig. 5). The processor of '89, in response to the prompt, is configured to randomly select and display at the display a combination of individual indicia selected from the inventory of indicia (Fig. 6), the selected and displayed indicia combination defining at least one outcome (Figs. 8a-c), and the processor is configured to remove the selected indicia from selection for future hands (indicia are depleted from inventory as certain combinations of indicia are no longer available when individual indicia are dealt from the inventory, if this were not

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the case the probabilities of the winning combinations would not change through the course of the game and the indicia would simply be randomly selected). It is widely known in the art to deplete indicia from a pool of indicia in a standard game of poker; see for example, "Scarne's Encyclopedia of Card Games," Pages 7 to 9. The processor is configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure (Figs. 8a-c), to issue an award for each selected and displayed winning outcome (Col. 8, Lines 31 to 42), to control the display prior to play of the next hand data corresponding to the remaining inventory of indicia sets depleted of the displayed game indicia including the display of indicia from the inventory such that one or more scheduled winning outcomes are unavailable due to depletion (Figs. 8a-c, the examiner notes that this claim language only requires the display of winning outcomes no longer available and not the display of remaining individual indicia). '809 gives the player the option to make another wager to play a next game (Col. 11, Lines 37 to 45) using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the play of the next game (Abst.; new deal, Fig. 2; new screen 42 of Fig. 4; Col. 3, Line 67 to Col. 4, Line 3). The displaying of remaining possible winning hand from one hand of play to another are obvious for the reasons outlined regarding Claim 15.

25. As to Claims 7, 17, and 27: '809 discloses reconstituting the inventory to X number of indicia when all of the major prizes have been awarded (Abst.). '809 does not disclose reconstituting to X indicia when a predetermined number of indicia remain in inventory. The applicants have not stated how this limitation solves any stated

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problem or is for any particular purpose. '809 does disclose reconstituting the pool of indicia at any time an indication is received by a player after at least one chance has been played (Abst.). 7In any event, this limitation is widely known in the art. Scarne in his chapter on Blackjack discloses a cut card 40 cards above the bottom of the stack of cards when cards are dealt from a stack comprising four decks of cards (Pages 282 to 284). The stack is automatically reshuffled when the cut card is revealed. This, along with the use of four decks instead of one, makes card counting extremely difficult and is a deterrent to cheating. Scarne also teaches the dealer reconstituting the deck at any time upon noticing player actions (Page 287), again, to prevent cheating. The examiner believes that this is sufficient motivation to make this modification to the game of the combination of '894 and '809. Moreover, the 103 combination of '894 and '809, or the applicants' own invention, would perform equally well modified to incorporate this limitation. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified '809 or '894 such that the deck is reconstituted when a predetermined number of indicia remain in the inventory, because such a modification would have been an obvious design choice which fails to patentably distinguish above these references.

26. As to Claims 8, 14, 18, and 22: '809 randomly selects and displays indicia by arranging the indicia into a random, serial order 1 through X and selects and displays the indicia in order from the arranged inventory (Fig. 5A).

27. As to Claims 12 and 21: '894 allows the player to bet on a single payline (single hand of cards, Fig. 6). '894 does not address the limitation of multiple paylines. '809



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does suggest this as it allows players to play multiple parallel games at the same time (Fig. 3). The 103 combination of '894 and '809 would thus have multiple paylines. The applicant has not stated that multiple paylines solves any stated problem or is for any particular purpose; it appears to be merely another embodiment. Moreover, it appears that '894, or the applicants' invention would perform equally well modified to incorporate multiple paylines. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified '894 to incorporate multiple paylines, because such a modification would have been considered a mere design choice which fails to patentably distinguish above '894.

28. As to Claims 16, 20, and 28: '809 gives the player the option to make another wager to play a next game (Col. 11, Lines 37 to 45) using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the play of the next game (Abst.; new deal, Fig. 2; new screen 42 of Fig. 4; Col. 3, Line 67 to Col. 4, Line 3).

### ***Response to Arguments***

29. Applicant's arguments filed 5-31-2007 have been fully considered but they are not persuasive. The previous 101 rejections are withdrawn. Regarding the hand-to-hand play of '894, the examiner respectfully disagrees with the applicants on this regard. The player of '894 is able to insert plural medals (Col. 4, Line 66 to Col. 5, Line 14). The player is able to bet one medal on a particular hand (5:50-65 "an inserted

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medal," also "1 BET" button 33, Fig. 4; the player is able to bet one or plural medals on a given hand, "1 BET" 33 or "MAX BET" 32, Fig. 4, Col. 6, Lines 43 to 59; Col. 8, Lines 42 to 53, play continues until the player runs out of medals or player presses "COLLECT/PAYOUT", in the event the player inserts plural medals and the player only bets one medal per hand by pressing "1 BET" each time, the game will necessarily involve hand-to-hand play of several subsequent hands for at least as long as the player has medals, for example if the player inserts five medals the player will have at least five hands to play in the game, and each time the indicia left in the deck of virtual cards will be more depleted as more cards are dealt from the deck on each successive hands). The cards in '894 are randomly generated and are not in any particular order (Col. 3, Lines 58 to 62. It is widely known in the art that a standard poker deck used in most poker games is a 52-card deck with 4 suits of 13 cards each, and the possible combinations of '894 are eliminated as indicia are drawn, so a pool of finite indicia is depleted, though it is not generated or constituted in a predetermined serial order which is not required by the claim language.

30. Alternatively, Fuchs teaches hand-to-hand display of remaining game indicia in a video poker game (Figs. 1 to 3; indications of possible winning ways in a poker game, 6:6-36; more general teaching, Fig. 5, 9:52-67). The Board noted in the related 09/977,138 case: "We acknowledge that the sections of Fuchs the examiner relies upon appear to disclose depletion of the group of symbols (cards in a deck) over several games. However, in our review of Fuchs we find that Fuchs' uses the term game to mean an additional play of cards, i.e. Fuchs uses the term game to both describe the

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inter hand deal of cards and the intra hand deal of cards. See for example Fuchs states, in column 6, lines 20-25: 'In the present case, since it is a type of poker game that is being played, the computer unit 5 has suggested that two game symbols 3', namely the two aces, should be stored and at the same time it displays the possible ways of winning the next game by obtaining five, four or three aces and the possible ways of winning are assigned various values in the display fields .... ' Thus, we find it clear that Fuchs is using the term game to include the deal of cards within a hand of poker. Further, we find no examples in Fuchs that discuss the deck of cards is not being reconstituted and randomized between segments of play where wagers are distributed (i.e. hands of poker). Rather, we find that Fuchs is ambiguous as to whether the deck of cards is reconstituted and randomized, or is allowed to be depleted, between hands." It would have been obvious to one of ordinary skill in the art to apply the hand-to-hand indication of possible winning hands of Fuchs to the game of Kinoshita '894. Depleting a set of indicia, or deck of cards, from hand to hand would create a much more realistic game. The examiner notes the following from Scarne ("Scarne's Encyclopedia of Card Games," by John Scarne, 1970, HarperCollins, New York, Poker chapters): On Page 14 indicating the basic draw poker rules, if there are not enough cards in the deck to complete the current deal, the discards can be shuffled and dealt. Also it is recommended that two decks be used so that a player can call for a change of decks after the present deal is done. Moody in U.S. patent 5,823,873 A discusses a poker game in which multiple hands are dealt from a set of indicia comprising six 52-card decks dealt from a shoe (12:44-60). It is thus well known in the art to deal multiple

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hands from a single deck of cards or a pile of cards comprising more than one deck in a poker game. Applying this to the display of remaining possible hands of '894 would have the effect and advantage of making the poker game of '894 much more realistic and instructive since the remaining hands over the course of the game will be displayed instead of just the possible hands remaining on a single hand of play based on the cards drawn on that particular hand. The examiner respectfully disagrees with the applicants as to the claims' condition for allowance.

### ***Conclusion***

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel  
Patent Examiner  
AU 3714



Robert E. Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714